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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,033	05/10/2001	Guoping Zhang	12126	7868
22204	7590	09/14/2005		
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER FETZNER, TIFFANY A	
			ART UNIT 2859	PAPER NUMBER

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/852,033	Applicant(s) ZHANG, GUOPING	
	Examiner Tiffany A. Fetzner	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) 46-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-23 and 25-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED first Action after RCE

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 10th 2004 has been entered.

Drawings

2. The objections to the drawings from the office action of March 28th 2003 are **rescinded** in view of the red-ink proposed drawing changes to figures 5, 8B, 11 and 13A; in combination with the amendments to the disclosure concerning the drawings of the September 29th 2003 amendment response. [See also the remarks on pages 19 and 20 of the applicant's September 29th 2003 submission.]

3. The examiner has approved the proposed red-ink drawing corrections of the September 29th 2003 amendment response.

4. A complete Set of New Formal Drawings which include the approved Red-ink changes of the September 29th 2003 amendment response are now needed, in order to ensure that the need for a new complete set of formal drawings will not prevent the instant application from becoming a patent when the remaining issues are resolved, and the instant application is moved toward allowance by the examiner.

Specification

5. The objections to the disclosure from the office action of March 28th 2003 are **rescinded** in view of the September 29th 2003 amendment response.

Canceled claims

6. **Claims 13, 24 and 46-70** have been canceled as per applicant's September 10th 2004 Amendment and response.

Claim Objections

7. **Pending claims 1-12, 14-23, and 25-33** are objected to because the applicant's September 10th 2004 Amendment and response, which was sent via fax has a 4mm

Art Unit: 2859

black line passing through the right hand side of all pages and all text of the September 10th 2004 Amendment and response.

8. While the examiner is able to guess in most of the blurry claim lines, from context, what the unreadable text is stating, blurry amendments are not in proper form for allowance.

9. The examiner requests that applicant resubmit the September 10th 2004 amendment and response, in combination with the applicant's response to the remaining issues noted by the examiner in this office action, since a few of the claims still have some structural aspects which are not positively recited. (i.e. intended use is not a positive recitation of a feature, and is not granted patentable weight in apparatus claims.) In order to place the pending claims in condition for allowance the remaining concern over "intended use" versus "active recitation" must be resolved. The examiner notes that the active recitation of all features within the pending claims is not taught by the prior art of record; therefore by resolving the issue of "positive recitation" versus "intended use" applicant disqualifies the prior art of record from being applicable to the pending claims.

10. The following specific objections/corrections are based on the claims and response of September 10th 2004.

A) **Claim 1:** line 2 after "window" **delete** "for".

B) **Claim 1:** line 4 after "sequence editor item" **delete** "for creating" and **insert either** "which creates" **or** "that creates".

C) **Claim 1:** line 5 after "sequence tailor editor item" and **insert** "configured" so that the "for" becomes "configured for".

D) **Claim 1:** line 12 **delete** "a scan" and **insert** "an MRI scan" (applicant note this change is needed to correct an antecedent problem with **dependent claims 14 through dependent claim 18.**)

E) **Claim 1:** line 12 after "menu editor item" **insert** "configured" so that the "for" becomes "configured for".

F) **Claim 3:** line 3 **delete** "for" and **insert** "operative in".

Art Unit: 2859

G) Claim 9: line 3 **after** "selected pulse sequence" **insert** "which is displayed to the user". This correction ensures that the antecedence of the pulse sequence comes from claim 1, since claim 9 relies on the features of **claims 1, 7, and 8**.

H) Claim 10: line 3 **delete** "for assisting" and **insert** "in order to assist".

I) Claim 10: line 3 **delete** "relations" and **insert** "relationships".

J) Claims 14 through 18 depend from **canceled claim 13, which** is improper. In order to correct this problem the examiner suggests the following corrections:

J1) Amend claim 14 to depend from claim 1.

J2) Claim 14: line 2 **after** "at least one type of" and **insert** "MRI".

J3) Claim 15: lines 1-2 **after** "at least one type of" and **insert** "MRI".

J4) Claim 16: line 1-2 **after** "said type of" and **insert** "MRI".

J5) Claim 16: line 2 **after** "at least one setting" **insert** "of an".

J6) Claim 16: line 2 **after** "said setting" **insert** "of the".

J7) Claim 17: lines 1-2 **after** "at least one setting" and **insert** "of an".

J8) Claim 18: lines 1-2 **after** "at least one setting" and **insert** "of an".

K) Claim 19 last line **after** "at least one setting" **insert** "of an".

Response to Arguments

11. Applicant's arguments filed September 10th 2004 have been fully considered and are persuasive at overcoming the prior art of **Kasten et al.**, because the amended claims of September 10th 2004 now require that the pulse sequences used throughout the claims, are: dynamic, non-standard, and "on the fly" manipulations of, and modifications to, said graphical representations of the pulse sequence(s) applied in real time, in a manner that is distinguishable from the "canned only" approach of **Kasten et al.**, which is not capable of non-standard pulse modifications. The examiner agrees that the **Kasten et al.**, reference uses only a "canned" customization approach to magnetic image sequencing formation as per page 9 paragraph 4 of the September 10th 2004 arguments and response, which is not capable of non-standard customizations in real-time.

Double Patenting

Art Unit: 2859

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

13. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

14. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. **Claims 1-12, 14-23, and 25-33 are rejected** under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claims 1-44** of U. S. Patent No. **6,801,037** Although the conflicting claims are not identical, they are not patentably distinct from each other because the MRI initializing user interface of the instant application is an MRI system component usable with applicant's U. S. Patent No. **6,801,037** MRI system. Both the instant application and U. S. Patent No. **6,801,037** have features, and limitations, which cause the scope of the claims in these applications to overlap. In order to obviate any confusion between the MRI initializing pulse sequence user interactive interface of the instant application and the MRI interactive system of applicant's own U. S. Patent No. **6,801,037** a terminal disclaimer is needed. The patent and the instant application are related as combination / subcombination. The instant applications interface is compatible with applicant's MRI system of the U. S. Patent No. **6,801,037** and therefore the scope of the claims in both the application and patent cover the same novel aspects with one application drawn to the interface, and the Patent drawn to the main MRI system.

16. The **prior art made of record** and not relied upon is considered pertinent to applicant's disclosure.

A) ***Whayne et al.**, US patent 6,014,581 issued January 11th 2000 entitled "Interface for Performing a diagnostic or therapeutic Procedure on the Heart Tissue with

Art Unit: 2859

an Electronic Structure". Other related class/subclasses include: 600/525; 600/300; 128/920.

- B) *Kasten et al., US patent 5,317,260 issued May 31st 1994.
- C) Haney et al., US patent 4,191,919 issued March 4th 1980.
- D) Keller et al., US patent 5,041,789 issued August 20th 1991.
- E) Hoenninger, III US patent 5,465,361 issued November 7th 1995.
- F) Kasuboski US patent 5,349,294 issued September 20th 1994.
- G) Hoshino et al., US patent 6,484,048 B1 Issued November 19th 2002 ; filed October 21st 1999.
- H) Rittman, III et al., US patent 6,451,015 B1 issued September 17th 2002, filed November 18th 1998.
- I) Rittman, III et al., US patent application publication 2003/0032951 A1 published February 13th 2003, filed November 18th 1998. which corresponds to Rittman, III et al., US patent **6,451,015 B1** issued September 17th 2002, filed November 18th 1998.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tiffany Fetzner whose telephone number is: (571) 272-2241. The examiner can normally be reached on Monday-Thursday from 7:00am to 4:30pm., and on alternate Friday's from 7:00am to 3:30pm.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached at (571) 272-2245. The **only official fax phone number** for the organization where this application or proceeding is assigned is **(571) 273-8300**.



TAF
September 12, 2005



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800